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SHAPER ILER LLP 1800 WEST LOOP SOUTH SUITE 1450 HOUSTON, TX 77027			EXAMINER GANEY, STEVEN J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIGHT WILLIAMS

Appeal 2009-010882
Application 10/081,419
Technology Center 3700

Before: JENNIFER D. BAHR, STEFAN STAICOVICI, and FRED A.
SILVERBERG, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 2, 5-9, 13, and 15-17. Claims 3, 4, 10-12, and 14 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A fire fighting system comprising:

pumping at least 2000 gpm water from a large water reservoir toward an industrial hazard using a standard pump having a water manifold inlet but no special approximately 2 ½ inch inlet; and

adding, in an around-the-pump system, at least one water additive from a water additive source to the pumped water through a fitting at least initially separate from the standard pump, the fitting established on a suction side of the pump upstream of the pump water manifold inlet and in fluid communication between a reservoir outlet and the suction side.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hollan	US 4,234,044	Nov. 18, 1980
Gagliardo	US 4,503,915	Mar. 12, 1985
Worthington	US 5,398,765	Mar. 21, 1995
Williams	US 5,829,533	Nov. 3, 1998

REJECTIONS

- I. Claims 1, 2, 5-8, 13, 16, and 17 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.
- II. Claims 1, 2, 5-8, and 17 are rejected under § 101 as being directed to non-statutory subject matter.

- III. Claims 1, 2, 5-9, 13, and 15-17 are rejected under § 103(a) as unpatentable over Hollan and Williams.
- IV. Claims 1, 2, 5-9, 13, and 15-17 are rejected under § 103(a) as unpatentable over Hollan and Worthington.
- V. Claims 1, 2, 5, 6, 8, 9, 13, and 15-17 are rejected under § 103(a) as unpatentable over Gagliardo and Williams.

SUMMARY OF DECISION

We REVERSE.

ISSUES

The Examiner's position in rejections I and II is that the claims improperly mix the statutory classes of method and apparatus, rendering the claim both indefinite and non-statutory. Ans. 4-5. Appellant argues that the claims properly qualify as method claims. Appeal Br. 5. Thus, the first issue is whether the claims rejected in rejections I and II are method claims.

The Examiner takes a further position in rejection II that claims 5 and 13 are indefinite because they omit essential structural components, namely that the claims do not positively recite the connection of the water manifold inlet with the line. Ans. 5. Appellant argues that no essential components are omitted. Appeal Br. 6. Thus, the second issue is whether claims 5 and 13 are indefinite for omitting essential structural components.

The Examiner's position in rejections III-V is that the negative claim limitation, "a standard pump having ... no special approximately 2 ½ inch inlet," does not further limit the independent claims. Ans. 7, 8, 9, 11. The Examiner additionally finds that both Hollan and Gagliardo describe a pump having "no special approximately 2 ½ inch inlet" because Hollan and

Gagliardo do not describe a 2 ½ inch inlet. Ans. 12-13. Appellant argues that “no special approximately 2 ½ inch inlet” limits the independent claims and that neither Hollan nor Gagliardo describe a pump without a 2 ½ inch inlet. Appeal Br. 8-9. Thus, the third issue is whether Hollan and/or Gagliardo describe a pump with “no special approximately 2 ½ inch inlet” as required by the independent claims.

OPINION

Issue 1: “System” claims containing method steps

A dictionary² definition of “system” includes “[a] method : procedure.” Claims 1, 2, 5-8, 13, 16, and 17 only recite method steps; no structure is claimed. Accordingly, claims 1, 2, 5-8, 13, 16, and 17 are not improper hybrid claims. Cf. *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (“Because [the claim] recites both a system and the method for using that system, it does not apprise a person of ordinary skill in the art of its scope, and it is invalid under section 112, paragraph 2.”). Therefore, it is clear that these claims are method claims directed to one of the enumerated statutory classes.

Issue 2: Omitting Essential Structural Components

Claims 5 and 13 both specify, essentially, that the fitting is located between the reservoir outlet and the suction side of the pump. The Examiner appears to require that the claims specify exactly to which component the fitting is connected. However, by not specifying which component the fitting is connected to, the claim is merely broad, not ambiguous. See *In re*

² *Webster's II New Riverside University Dictionary*, 1175 (1988).

Johnson, 558 F.2d 1008, 1016 n.17 (CCPA 1977) (breadth is not indefiniteness). That is to say, it is clear where the claim requires the fitting; no further detail is necessary to know the metes and bounds of the claim. Accordingly, claims 5 and 13 are not ambiguous.

Issue 3: No Special Approximately 2 ½ inch Inlet

The Examiner does not make a finding that Hollan, Gagliardo, Williams, or Worthington describes a pump *without* a “special approximately 2 ½ inch inlet.” In fact, we do not find any mention of the inlet size in either reference. The references’ lack of discussion of a 2 ½ inch inlet does not mean that their pump inlets are not 2 ½ inches; it merely means that it is unknown if their inventions have 2 ½ inch pump inlets. A negative limitation is still a limitation; the Examiner must still make a finding regarding this limitation. The Examiner states that “an inlet would be chosen depending on the size of the pump designed” but does not provide reasoning why it would have been obvious to use an inlet with a size different than 2 ½ inches. *See* Ans. 7. Accordingly, the Examiner has not set forth the initial factual basis required for a prima facie case of obviousness.

DECISION

For the above reasons, we reverse the Examiner’s decision regarding rejections I-V.

REVERSED

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